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CHARLES ELMORE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1930.

No. 315

HANNAH M. SMITH, Administratrix of ESTATE OF OWEN P. SMITH, Deceased,

Petitioner,

versus

SPRINGDALE AMUSEMENT PARK, LIMITED, PAUL M. WILLIAMS and GERALD BROWN.

On Writ of Certiorari to the United States Circuit Court of Appeals for the Sixth Circuit.

BRIEF ON BEHALF OF PETITIONER.

JOHN E. SATER,
E. HOWARD M'CALEB,
Counsel for Petitioner.

MONTGOMERY-ADDAMS PRINTING CO., INC., 410-412 CHESTNUT, N. W.

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BRIEF ON BEHALF OF PETITIONER.

OPINIONS OF THE COURT BELOW.

(I) *Smith v. Springdale Amusement Park, Limited, et al., 40 Fed. (2nd) 173* (R. p. 368); *Smith v. Springdale Amusement Park, Limited, et al., 39 Fed. (2nd) 92* (R. p. 89); *American Electric Rabbit, etc. v. Smith, 26 Fed. (2nd) 1016*, agreeing with conclusions in *Smith v. Ameri-*

can Electric Rabbit, etc., 21 Fed. (2nd) 366; see also *Magic City Kennel Club, Inc., et al., v. Smith, 38 Fed. (2nd) 170.*

JURISDICTION.

See petition and brief on application for writ of certiorari in this case.

STATEMENT OF THE CASE.

This is an equity suit for infringement of petitioner's patents relating to devices used in dog racing amusement (R. pp. 1 to 13, R. p. 60), being Patent No. 1,379,224, claims 1 and 2, (R. pp. 3, 60, 186 to 192c); Patent No. 1,507,439, Claim 1, (R. pp. 4, 60, 222 to 224) and Patent No. 1,507,440, claims 1, 2, 3, (R. pp. 5, 60, 254 to 256). Among other matters not material or not decided, respondents answered, denying validity of these patents and, if valid, they denied infringement (R. pp. 21, 23, 25, 26, 27, 31, 32, 36, 37, 40, 41, 45). After hearing (R. pp. 68 to 88) the District Judge decided that Claims 1 and 2 of Patent No. 1,379,224, for a dog racing device were valid but not infringed (R. p. 100); that Patent No. 1,507,440 for a housing for concealing tracks and cars having a laterally extending arm in a dog racing device was invalid but if valid was not infringed (R. p. 100) and Patent No. 1,507,439 for starting cage for racing dogs is valid but not infringed (R. p. 100), and accordingly dismissed the bill (R. p. 100). Petitioner thereupon appealed to the United States Circuit Court of Appeals for the Sixth Circuit (R. pp. 101 to 107) and, after hearing, said Sixth Circuit Court of Appeals affirmed the aforesaid decision of the District Court (R. p. 368). The case is before this Court on certiorari (R. p. 373).

Summary as to Patent No. 1,379,224, Claims 1 and 2.—This patent, admitted in evidence (R. p. 69), appears on pages 186 to 192c of the record. In his specifications, patentee Smith states that the invention consists of the arrangement and combination of parts described and claimed, and while the invention is not restricted to the exact details of construction disclosed, yet for the purpose of illustrating a particular embodiment thereof reference is had to the accompanying drawings (R. p. 189); and, in the drawings and specifications detailing the construction, the lure-carrying arm is hinged to the conveyor car and supported at its outer end by a rotatably mounted wheel. (R. p. 188, figure 3; R. p. 191). Claims 1 and 2 substantially describe the invention.

Claim 1. "In a dog racing amusement (1) a race course suited for dogs; (2) a casing extending around the outer side of the race course and provided with a longitudinal opening; (3) a mechanical conveyor including a track extending around the race course and located within the casing; (4) and a conveyor car mechanically operated upon said track and provided with an arm extending through the longitudinal opening of the casing in a projecting position over the track and adapted to carry a lure; (5) and a wheel rotatably mounted on and supporting the arm at the projecting end thereof".

Claim 2. "In an amusement, the combination (1) of a race track suited for dogs; (2) a covered rail track adjacent said course on one side; (3) a conveyor car mechanically operated on said track; (4) a horizontally extending arm hinged to said car extending midway of said

course; (5) a wheel rotatably mounted near the end of said arm, and resting on the ground; (6) a platform supported by said arm, and (7) a lure or quarry mounted upon said platform for attracting the dogs". (R. p. 192b).

It is not disputed that Respondents' apparatus is constructed in accordance with the patent to Creveling, No. 1,481,313 issued January 22, 1924, (R. p. 146; R. p. 119, *et seq.*) or about three years after the issuance of this Smith Patent No. 1,379,224. Nor is it disputed that Respondents' apparatus is substantially identical with the apparatus found to be an infringement in *American Electric Rabbit, etc. v. Smith, 26 Fed. (2nd) 1016* and *Smith v. American Electric Rabbit, etc., 21 Fed. (2nd) 366*, also constructed in accordance with the said Creveling Patent. Comparison of Claims 1 and 2 of this Smith Patent with Respondents' apparatus discloses an appropriation of the claims, except that Respondents' arm is rigidly supported or sustained on the car during operation, in lieu of the wheel support described and claimed. Respondents' apparatus is located on the left outer side of the course opposite the right outer side thereof, and Respondents' rigidly supported arm is retracted into the casing at the termination of the race by means of trip mechanism whereby the lure is made to disappear, whilst the arm and lure of the patent is made to disappear into the casing by means of switching the car. (R. pp. 71, 73, 75, 76, 77, 78, Defendants' Exhibit A. R. p. 140; Exhibit B. R. p. 141. See Creveling Patent Drawing 147, 148, 149, *et seq.*)

Summary as to Patent No. 1,507,439—Claim 1.—The single claim of this Patent is: "In a starting cage for racing dogs, (1) a frame comprising a box-like structure (2) divided into a plurality of compartments (3) and comprising walls formed of wire mesh partially covered with fabric, (4) individual rear doors for each of the compartments and (5) a single front door hinged at its upper end to the top walls of the frame, (6) divergent inclined members secured to the top of said frame and (7) extending upwardly and outwardly beyond the face of the front door and having their outer ends in the plane of the side walls of the box-like structure, (8) springs secured to the outer ends of said inclined members and to the door and lying in the plane of the hinges, and (9) a latch at the bottom of the cage for co-action with the lower edge of the front door to hold the front door normally closed against the tension of said springs, said springs adapted to raise the front door upon release of the latch". (R. p. 224).

In his specifications, the patentee says that the invention described and claimed is not restricted to the exact details of construction (R. p. 223) and: "It will be apparent that other means may be employed to raise the door 6, and other means may be employed to protect the dogs against injury in the stalls, without departing from the spirit of my invention". (R. p. 224).

Respondents have appropriated the claim, except that the walls of their compartment stalls are formed of wooden boards in lieu of wire mesh partially covered with fabric and except their inclined members are parallel, (non-divergent) instead of divergent (R. pp. 76, 78, 143, 144,

145), and except in lieu of ordinary tension springs they use elastic or aeroplane shock rubber. *(Ibid.)*

Summary as to Patent No. 1,507,440—Claim 1.—The claim is: "In a housing for covering tracks and cars having laterally extending arm operated on said track, the combination of (1) posts set in the ground at the sides of said track; (2) timbers attached to said posts to form a frame; (3) boards attached to said timbers and posts to form a continuous enclosure above said track; (4) and having a continuous opening in one side of said housing adapted to permit extension of the laterally extending arm therethrough; (5) truss rods attached to the closed side of said housing adapted to support the side of said housing above the said continuous opening." (R. p. 256). In his specifications, the patentee states, that the invention relates to means for concealing the track and conveyor car in a mechanical lure conveyor for dog racing courses (R. p. 255). He further states that the invention is not restricted to the exact details of construction, but for the purpose of illustrating a particular embodiment reference is had to the accompanying drawings (R. p. 255). This particular embodiment is shown in the drawings and in Claims 2 and 3 which provide for adjustable stay rods and adjustable screw threaded stay rods. (R. pp. 254, 256a).

Comparison of the illustrated cross section view of Respondents' housing with Claim 1 shows a literal translation of the Claim. (R. pp. 117, 142; R. pp. 71, 72, 76, 78).

SPECIFICATIONS OF ERROR.

The Sixth Circuit Court of Appeals erred in finding and holding:

(1) That Patent No. 1,379,224, Claims 1 and 2, are not infringed by Respondents,

(2) That Patent No. 1,507,439 if valid is not infringed by Respondents,

(3) That Patent No. 1,507,440 is invalid, but if valid is not infringed by Respondents.

ARGUMENT.

Summary of Argument as to Patent No. 1,379,224—Claims 1 and 2.—Considering the high rank of this patent in the art to which it relates, these claims are entitled to generous treatment and to a range of equivalents commensurate with the scope of invention; that having described and claimed his device in his preferred form, the patentee is entitled to all other forms which embody the substance of a lure-carrying arm horizontally extending from the conveyor through a continuous longitudinal opening of the casing located on either outer side of the race course; Respondents' substitution of the patentee's horizontal arm supported rigidly constitutes a colorable departure from the patentee's horizontal arm supported flexibly, both operating within the same principle, accomplishing the same result in substantially the same way, there being no breaking up or essential variation of that principle and mode of operation pervading the original invention; that said preferred movable or wheel support is neither a distinguishing characteristic of the device nor essential to its patentability nor material to its operation; that said wheel support finds

its mechanical equivalent in Respondents' form of rigid support of the patentee's arm, in that, either pertains to the working environment of the aforesaid inventive step, accessorial thereto and a matter of engineering selection; that no limitation is imposed on the patentee by the prior art, no disclaimer of equivalents for his said preferred form either in the specification, claims or Patent Office proceedings.

It is urged:

Point A. Said Patent (Claims 1 and 2) is entitled to a liberal construction and to a range of equivalents commensurate with its scope.

Point B. Patent Office Proceedings discloses no express limitations of patentee's preferred form.

Point C. Substitution of a rigid for the wheel support of the horizontal arm and locating the device on the left outer side of the race course, does not avert infringement.

Summary of Argument as to Patent No. 1,507,439— Considering that the essence of the invention consists in hinging the upper end of the exit door to the top walls of the frame in co-operation with inclined members secured to the top of the frame and extending upwardly and outwardly and connected with tension springs at their outer ends and to the bottom of the exit door for quickly raising said exit door upon release of the latch; that the invention is described and claimed in the preferred form; that Respondents' substitution of wooden board for wire mesh partitions partially covered with fabric and the change in

position of the inclined members from divergent to non-divergent as well as the substitution of rubber springs for "springs", embody change in non-essentials and are deliberate evasions of the claim involving no material change in function, operation or result; that neither the specifications, claims nor Patent Office proceedings contain an express limitation by way of estoppel or otherwise with respect to these elements; it is urged:

Point D. The invention is described and claimed in the preferred form.

Point E. Substitution of wooden board for wire mesh partitions, rubber springs for springs and arranging or locating the inclined members supporting the springs from divergent to non-divergent, do not avoid infringement.

Summary of Argument as to Patent No. 1,507,440—Claim 1.—Considering that Respondents' housing device contains all the elements of the claim in the same combination constituting identity in function, operation and result, it is urged:

Point F. Patent No. 1,507,440 is valid.

Point G. Respondents have infringed Claim 1 both in letter and spirit.

POINT A.

Patent No. 1,379,224 is entitled to a liberal construction.

Invalidity of this patent for want of invention or novelty is set up in the answer; but, that defense remains unsupported by evidence or not seriously assailed, leastwise, the Courts below have assumed its validity.

The prior art is exhibited in Pinard 1887 (R. p. 258), Moss (British) 1896 (R. p. 268), Walsh 1898 (R. p. 263), Smith 1912 (R. p. 275) and Everett 1913 (R. p. 271). Pinard (R. pp. 259, 260) and Moss (R. p. 269) show armless lure-carriers; Smith (R. p. 276) and Everett (R. p. 272), lure-conveyors concealed in an underground tunnel located between the inner sides of the race course, and provided with a vertical lure-carrying arm extending upwardly through a continuous slot on a level with the surface of the race course. Walsh (R. p. 264) proposes two race courses susceptible of being used together or alternately. Each race course is separated, as to one by a right outer fence and as to the other by a left outer fence. Between each fence and adjacent thereto he places his track and conveyor car. To protect both dogs and his travelling mechanisms and to conceal the mechanisms from the racing dogs, these fences must be high enough to prevent the dogs from leaping over the fences and that necessitates the employment of an arm extending upwardly and outwardly vertically inclined in transverse direction to reach over and clear the respective fences. It further necessitates, as shown, a connection at the end of this vertically inclined arm, of another arm, similar to a forearm (whether pliant as by the use of a cable or stiff by the use of a rod or pole) extending vertically downward to a lure-carrying mat dragging on the ground. All this involves the situation of having his angular or elbowed arms operating in relatively vertical planes. Due to the awkwardness of his angular arm in its relation to the car, high speeds involved and the curves encountered, a problem in mechanics and in the law of centrifugal force is presented but not solved, in view of the absence of evidence that it ever worked.

(b) Smith proposed a radical departure in principle. (R. pp. 187 to 192C). He connected the two necessary co-operating elements of conveyor car and lure by an arm horizontally extending over the race course, and from conveyor to lure in closest proximity as fundamentally necessary to a practical functioning at high speed. Retaining this basic idea as indispensable, he had to overcome the difficulty of concealing the travelling conveyor from dogs and spectators without in any way affecting the application of the principle. The prior art presented an impassable barrier; so he surmounted it by placing the protecting fence on the far side of the rail track conveniently and relatively distant from the nearest side of the race course, thence from its upper portion by carrying it over to and directly in front of the outer side of the race course, leaving a continuous opening for the free operation of his horizontal arm. In all this, he produced function never performed before, terminating in a new and useful result never achieved before—a successful and complete dog race in pursuit of an inanimate lure. (Compare *Smith v. Springdale Amusement Park, 39 Fed. 92*, at pages 93 and 94). Adoption of this principle or mode of operation pervading the invention has not been varied by Respondents is conceded.

But under *Sec. 4888, U. S. Rev. Stat.*, Smith was required to embody that principle in what he considered the best mode; and in his specifications and drawings he describes his best mode, reserving unto himself all other modes or forms by declaring that the described and claimed invention "is not restricted to the **exact** details of construction disclosed herein, yet for the purpose of illustrating a

particular embodiment thereof, reference is had to the accompanying drawings". (R. p. 189). This reservation thus carried into his claims is tantamount to claiming his device **substantially**, though not exactly, as described. *(Winans v. Denmead, 15 How. at pages 342, 343; Western Electric Co. v. La Rue, 139 U. S. 601, 606)*. In other respects that was unnecessary *(United States v. Societe, etc., Cail, 224 U. S. 309, 328)* for he teaches how to practice his invention in his preferred form by describing and claiming his horizontal arm as being hinged (Claim 2, R. pp. 192b, 188, member 25) to the conveyor car, and near or at its outer end supported by a wheel rotatably mounted (R. p. 191); in short, that the wheel supports the hinged arm; and further, that the casing be located on the exterior or grandstand outer side of the race course as distinguished from its interior or infield outer side (R. p. 186). As Respondents support Smith's arm by a rigid in lieu of the preferred wheel support and transfer his casing from the preferred right outer side to the left outer side of the race course, the question is, does the substitution and transfer avoid infringement of either claim or both.

(c) We believe that this patent exhibits the application of a principle in dog racing devices theretofore unseen and new elements and functions not thought of or found in the prior art whereby a result dreamed of but never achieved culminated in the first successfully operating apparatus evidencing "the important but long delayed and therefore not obvious step", and on the basic idea of which all subsequent devices must necessarily depend. *Hildreth v. Mastoras, 257 U. S. 27, 34; Westinghouse v. Boyden, 170 U. S. 537; Hobbs v. Beach, 180 U. S. 383, 399.*

Smith's application for patent was filed in September, 1919, (R. p. 189); and whilst the burden is on Respondents, they have failed to show that any thing or any body produced an operatively successful device or complete dog race of this character, experimentally or otherwise. *Hildreth v. Mastoras, 257 U. S. 27, 33; Caffin v. Ogden, 85 U. S. 120.* The prior art shows that for over a third of a century others have tried, patents have issued, but nobody ever succeeded or used them or attained any operative success. And it is undisputed, that prior to this Smith 1921 patent application, dog racing in pursuit of an inanimate lure was unknown (R. pp. 74, 83, 84, 85). The only evidence of an attempt was made by Smith in 1910 or 1912 when he sought to get a dog race out of his 1912 patent; that attempt resulted in operative failure and was abandoned. (R. pp. 73, 74). Added recognition is given by tributary inventors who claim an addition or improvement only for retracting Smith's horizontal lure-carrying arm into his casing after the race is run, to an inoperative position. (See Creveling Patent 1924, R. p. 146, 147, 148). *American Electric Rabbit, etc., v. Smith, 26 Fed. [2nd] 1016; Smith v. American Electric Rabbit, etc., 21 Fed. [2nd] 366, 371).* It is believed that the character of the invention falls within the criteria established in *Hildreth v. Mastoras, 257 U. S. 27, supra,* and kindred decisions.

Liberal construction of these claims should be accorded in view of *Hildreth v. Mastoras, 257 U. S. 27; Eibel Process v. Minnesota Co., 261 U. S. 45, 63* (see also, *Smith v. American Electric Rabbit, etc., 21 Fed. [2nd] 366; 370).* And whether or not Smith is to be considered a pioneer in the nebulous meaning of that term, he "the

patentee having described his invention and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law deemed to claim every form in which his invention may be copied, unless he manifests an intention to disclaim some of these forms." *Winans v. Denmead, 15 How. 330, 342, 343; Western Electric v. LaRue, 139 U. S. 601, 606; Hoyt v. Horne, 145 U. S. 302, 308, 309; Sanitary Ref. Co. v. Winters, 280 U. S. 30; McSherry v. Dowagiac Co., 101 Fed. 716, 721 (C. C. A. 6); Dowagiac Co. v. Minnesota Moline Co., 118 Fed. 136, 140, 141, (C. C. A. 8).* As neither specifications, claims, nor prior art show a disclaimer of all forms of Smith's horizontal lure-carrying arm, we next inquire whether he has limited himself by estoppels in the Patent Office proceedings.

POINT B.

Patent Office Proceedings disclose no express limitations of patentee's preferred form.

The decision of the Sixth Circuit rests principally on the finding that "As both (hinge and wheel support) were specifically relied upon by the patentee in his specifications and claims and were regarded by the Patent Office as essential to avoid references in the prior art they are to be treated as limitations". (R. p. 370; *Smith v. Springdale, etc., 40 Fed.* [2nd] *at page 175).* This is error. Having shown that there is nothing in the specifications and claims indicating a disclaimer of other forms of support, it is submitted that the Patent Office, in opposition to the Court's finding, had **disregarded** the flexible support as essential to avoid references in the prior art,

and has, on the contrary, regarded the flexible support as non-essential, involving neither invention nor novelty either on an existing organization or on the claims, thereby recognizing the patentee's form described and claimed as preferential. In other words, it was regarded by the Patent Office and by Smith that whether the arm of the prior art or Smith's arm was supported or operated rigidly or flexibly was immaterial.

In approaching the File Wrapper, we put aside for brevity's sake, the rejected original, amended and revised claims 1 and 2 (R. pp. 160, 163, 165, 168, 169, 171) since these claims relate to an armless lure conveyor similar to Pinard (R. p. 260) and Moss (R. pp. 268, 269), and a housing for concealing it, the ground of rejection being that as Moss was provided with a housing, it would not be invention to provide a housing for an armless lure conveyor as claimed in these rejected original, amended and new claims 1 and 2 (R. pp. 160, 163, 165, 168, 169, 171).

As those two rejected, amended and revised claims are not concerned with the claims in suit or the offending device, it is to inquire whether or not Smith's special reservation contained in his specifications (R. p. 189) and the reservations accorded him by law *(United States v. Societe Anonyme, etc., Cail, 224 U. S. 309, at page 328*, and cases there cited) as to his preferred form of supporting his horizontal arm by a wheel support, has, notwithstanding the reservation, been restricted to that form only or otherwise reduced to an express limitation as to form by way of estoppels contained in the File Wrapper.

That inquiry brings us to rejected original as amended and allowed Claim No. 3, (R. pp. 160, 163, 165, 168, 169, 171). Original Claim No. 3, reads as follows:

> "3. In an amusement, the combination of (1) a race track suited for dogs, (2) a covered rail track adjacent said course, (3) a conveyor car mechanically operated on said track (4) **an arm attached to said car extending midway of said course,** (5) **a wheel rotatably mounted on said arm,** and (6) a lure mounted on said arm". (R. p. 160),

This original claim 3 was rejected on Walsh 611, 876, October 4th, 1898, (R. p. 163). As the Examiner "contents himself with a reference, we look to the matter referred to, to ascertain his meaning." *(Vroonan v. Penhollow, 179 Fed. 296, 305 [C. C. A. 6]; Frey v. Marvel, 236 Fed. 916, at page 922 [C. C. A. 6]).* Turning to the Walsh patent (R. p. 264), we find a race track suited for dogs, an uncovered rail track adjacent said course, a conveyor car mechanically operated upon said track, **an arm attached to said car extending midway of said course;** but we do not find a covered rail track or a wheel rotatably mounted on said arm or a lure mounted on said arm. Accordingly, the necessary inference from the Examiner's objection was, that there is neither invention nor novelty in supporting an extending arm by a wheel rotatably mounted (C. D. 1897, p. 694). Uninformed of the specific ground of objection, Smith amended the claim still retaining, "an arm attached to said car extending midway of said course", and "a wheel rotatably mounted on said arm", so as to read as follows:

> "Claim 3. In an amusement, the combination of (1) a race track suited for dogs, (2) a—rail track

adjacent said course, (3) a conveyor car mechanically operated on said track (4) **an arm attached to said car extending midway of said course,** (5) **a wheel rotatably mounted on said arm,** (6) a lure mounted on said arm—and a casing extending around the race course and receiving and concealing the track and the conveyor car and provided with a longitudinal opening through which the said arm extends." R. p. 165.

In presenting this amendment, Smith's attorney remarked "Claims (2 and 3) against which the Walsh Patent was cited have (has) been amended to include the housing extending around the track and concealing the mechanical conveyor. This element is not present in the Walsh Patent". (R. 167). As thus amended, the claim was again rejected in these words: "Claims 1, 2 and 3 are rejected on either Walsh or Moss, both of record. Moss is provided with a housing and it would not be invention to provide Walsh with one". (R. p. 168). From this rejection, it is clear, the Examiner then considered that the claim read on Walsh and it constituted neither invention nor novelty, to encase Walsh's conveyor car having "an arm attached to said car extending midway of said course"; and furthermore, the twice repeated inclusion of "a wheel rotatably mounted on said arm" involved neither invention nor novelty, but a detail, mechanical selection or form of supporting an extending arm insufficient to distinguish it from the art of record, otherwise the claim would have been allowed as a patentable improvement on Walsh.

Although the Examiner limited his objections to the Walsh Patent and to housing his conveyor car having an extending arm, it is apparent that Smith's attorney broadly

claimed an extending arm irrespective of its angularity or an arm extending upwardly, outwardly and thence downwardly, as in Walsh, or whether it operated in a vertical plane, whereas the gist of Smith's invention, its fundamental element, principle and mode of operation was the straight out lure—carrying arm laterally extending and operating exclusively in a substantially horizontal plane. Accordingly, this original claim 3 as amended was cancelled (R. p. 169) and a new claim propounded as follows:

> "3. In a dog racing amusement, (1) a race course suited for dogs, (2) a casing extending around the outer side of the race course and provided with a longitudinal opening, (3) a mechanical conveyor including a track extending around the race course and located within the casing, (4) and a conveyor car operated upon said track and (5) provided with an arm extending **through** the longitudinal opening of the casing **in a projecting position over the track** and adapted to carry a lure, (6) and a wheel rotatably mounted on and supporting the arm at the projecting end thereof". (R. p. 169).

In his remarks, Smith's attorney challenged the Examiner to point out a casing as called for in either of the three claims, for he says: "Applicant is unable to find such a casing in the British patent to Moss and the Examiner is respectfully requested to apply the references to the extent of pointing out where this housing is shown". (R. p. 170). To which challenge, the Examiner responded as follows: "Case reconsidered as amended Nov. 10, 1920, Claims 1 and 2 are again rejected on Moss. The housing of Moss is Member 28. The remaining claims appear allowable". (R. p. 171).

Right here, as already observed, Claims 1 and 2 merely claimed a housing or casing extending around the race course receiving and concealing the conveyor car (R. pp. 160, 165), and made no claim for a casing provided with a longitudinal opening as in Claim 3, nor did Claims 1 and 2 claim an extending arm at all; but these Claims 1 and 2 contemplated and claimed an armless mechanical conveyor as in Pinard and Moss. This affords the reason why the Examiner rejected Claims 1 and 2 (R. pp. 160, 165), and accepting the challenge he said: "The housing of Moss is member 28. The remaining Claims (Claims 3, 4, 5, 6) appear allowable". Again turning to the Moss Patent (R. pp. 268b, 269), member 28 is a "hood" protecting a trolley wire within the race course proper and sinuously extending around it but not on either of its outer sides. In consequence, whilst the Examiner rejected Claims 1 and 2, he allowed Claim 3 (R. p. 171) and after adjustment of the numerals (R. p. 172) the allowed Claim 3 became Claim 1 of the Patent. *(Hildreth v. Mastoras, 257 U. S. 27, 33, 34).*

Parenthetically, in the rejected and original Claim 3 and as amended, the wheel support is included and reads: "A wheel rotatably mounted on said arm", whilst in allowed Claim 3, it reads "a wheel rotatably mounted on and supporting the arm at the projecting end thereof". (Compare R. pp. 160, 165, 169). This is a mere change of expression having substantially the same meaning, although not required by the Examiner, but in view of the

specifications, that change in expression clarifies the clause according to the description (R. p. 191) in that the function of the wheel is to support the arm *(Hubbel v. United States, 179 U. S. 77, at page 80)*.

Now, comparing this allowed Claim 3 (R. p. 171) with rejected Claim 3 (R. pp. 160, 163) as amended (R. pp. 165, 168, 169) it is clear, that in the rejected original and amended Claim 3, the arm element was broadly claimed, thusly: "an arm attached to said car extending midway of said course". That clause plainly and broadly covered an arm vertical or vertically inclined and operating in a vertical plane as in Walsh (where his extending upper portion of the arm reached upwardly in transverse direction vertically inclined to clear his fence and his jointed forearm directed vertically downward) as well as a horizontally extending arm and operating in a horizontal plane, as in Claim 4 of the File Wrapper, Claim 2 of the Patent. Evidently, the Examiner had this distinction in mind during the course of his examination, and it was not until the contested Claim 3 was framed to restrict the **position** of the arm as extending **through** the longitudinal opening of the casing in a projecting position **over** the track, that the claim was allowed. Herein lies the dominating element, so recognized by the Examiner in his allowance of Claim 3.

Smith's attorney at all times insisted that the casing provided with a longitudinal opening and in which the conveyor car and tracks were located and co-operating with the arm was new, and although the examiner had by his rejection of amended Claim 3 disagreed, nevertheless he

finally yielded to Smith's insistence as shown by his final rejection of Claims 1 and 2 and his final allowance of Claim 3. But aside from the Examiner's concession, Respondent's device contains that and all the fundamental cooperating elements, the departure from the letter of the claim consisting in the form of supporting the arm.

Nowhere in the File Wrapper, or in the prior art or in the specifications, is there to be found anything whereby the Patent Office or the patentee had regarded the wheel support of the arm as exclusive of all other forms of support or as constituting it a distinguishing characteristic. Smith at no time was required to limit himself to a wheel support in order to secure the allowance of his claims. *Bundy v. Detroit, etc., 94 Fed. 524, 542, 543 (C. C. A. 6).* Accordingly, the element of wheel support of the arm remains unaffected as to the patentee's preferred form, freed from the charge of an express limitation, separable from the substance and pertaining solely to the working environment of the inventive step. *(Bundy v. Detroit, supra).*

Reduced, therefore, to a final analysis, the difference between rejected and as amended Claim 3 and allowed Claim 3, is clearly defined. By the rejections and Smith's acquiescence therein, he has disclaimed broadly an extending lure-carrying arm attached to the conveyor car, whereas by the allowance he has limited himself to a lure-carrying arm extending through the longitudinal opening of the casing in a projecting position over the track, nowhere to be found in the prior art. This is the limiting effect of the rejection, and reading directly on Respondent's de-

vice. For since estoppels must rest on a definite basis, the familiar rule followed in *I. T. S. Rubber Co. v. Essex, 272 U. S. 429, 444*, and kindred decisions does not carry over; nor does it contemplate a net result as a limitation on every element in the allowed claim; nor does it resolve the patented device or an accessorial element claimed in the preferred form into a disclaimer of all other forms, particularly where that preferred form is outside the gounds of rejection or not controlled by the references of the prior art. *Crown Cork & Seal Co. v. Sterling, 217 Fed. 381, at pages 390, 391, 392 (C. C. A. 6); Vroonan v. Penhollow, 179 Fed. 296, 305 et seq. (C. C. A. 6); Wayne v. Benbow-Brammer, 168 Fed. 271, 278, 279 (C. C. A. 8); National Hollow B. B. Co. v. Interchangeable Co., 106 Fed. 693, 713, 714 (C. C. A. 8); Bundy v. Detroit, etc., 94 Fed. 524, 543; Hildreth v. Mastoras, 257 U. S. 27, 33, 34.* In short, the estoppel is co-extensive with the disclaimer and no further, for "to be estopped by the action of the Patent Office, the patentee must be shown to have surrendered something which he **now** claims in order to obtain that which was allowed". *Bundy v. Detroit, supra.* Smith was never required to surrender anything except as stated; and when we limit him to the lure-carrying arm extending through the continuous longitudinal opening of the casing in a projecting position over the track we have given to the rejections of claim 3 every effect that is required.

As no question was raised in the Patent Office proceedings in respect to the location of the casing, and by the rejections and acquiescence in original and as amended Claim 3, the Patent Office decided and Smith conceded that the wheel support disclosed neither invention nor

novelty, was not the distinguishing characteristic of the claim but an accessorial element involving mechanical selection, it is easy to perceive the sounder reasoning and the inappositeness of the cited cases by realizing that self-imposed limitations or estoppels in the Patent Office proceedings are to be marked off according to the issue therein definitely raised and determined. *Hildreth v. Mastoras, 257 U. S. 27, 33, 34.*

In view, therefore, of the foregoing, it is urged that the Sixth Circuit committed error in finding and holding that "As both (hinge and wheel) were specifically relied upon by the patentee in his specifications and claims and were regarded by the Patent Office as essential to avoid references in the prior art, they are to be treated as limitations". *(Smith v. Springdale, etc., 40 Fed. [2nd] at page 173; R. p. 370).* And the Fifth Circuit was right in finding and holding that "A reading of his claim in the light of his specifications does not suggest an intention to restrict himself to the use of the wheel and hinge on the projecting arm, which might well have been rigid instead of flexible as far as function and operation were concerned. **There is nothing** to show his intention to relinquish to the public all forms in which his invention might be embodied" (citing authorities). *Smith v. American Electric Rabbit, 21 Fed. (2nd) 366 at page 371; Ibid. 26 Fed. (2nd) 1016.*

Turning to the opinion in *39 Fed. (2nd) supra*, we believe that full consideration of the File Wrapper is lacking in failing to observe the distinction, raised by the examiner and acquiesced in by Smith, between broadly claiming "an arm attached to said car extending midway

of said course" and restrictively claiming "an arm extending through the longitudinal opening of the casing in a projecting position over the track"; the former reading on Walsh's angular vertically inclined transverse directed arm; the latter on Smith's horizontal arm. Smith is not now claiming that his allowed claim has the same breadth and scope of the rejected claim, nor does he now claim that Walsh's arm is equivalent to his arm, nor is it pretended that Respondents are using Walsh's arm, but it is conceded that they are using Smith's.

(b) Coming to Respondent's contention refuted by the opinion of the Fifth Circuit Court of Appeals, that as Respondent's casing is located on the interior outer side relative to its race course, or side facing the infield or inner oval, the location of the casing in allowed Claim 3 is reduced by estoppel to the exterior outer side or side facing the outfield or grandstand.

At no time was the location of the casing required to be restricted to the exterior outer side. The rejection was confined to the Examiner's holding that it was not invention to provide Walsh's rail track and car with a casing. In revising allowed Claim 3, the casing was claimed substantially as described in the preferred location. There was nothing in the rejections or rejected claims nor in the prior art that imposed such a limitation as contended for. Aside from the location claimed, being the one preferred by reference to the specifications and drawing (R. p. 186), the term "outer side" is broad enough to include either outer side as "a race course suited for dogs" comprises any shape or size desired, whether rec-

tangular straight-of-way or parallelistic oval having two external sides or fences oppositely disposed and constituting the race course, (as distinguished from a circular plane surface) either of which has two outer sides—right outer and left outer, as well as between which there are two inner sides—right inner and left inner.

POINT C.

Substitution of a rigid for the wheel support of the horizontal arm and locating the device on the left outer side of the race course does not avert infringement.

(a) Vice of the adverse opinions below lies in assuming that Smith's sole contribution was formal by prescribing flexibility to an extending lure-carrying arm. But that flexibility (even if it involved invention albeit denied by the Patent Office and by Smith according to the File Wrapper) is not claimed as tributary to a prior organization whether pictured in a paper patent or publication or existing in point of fact. The art and its history shows that something more than form was left in the inventive field, in that the art lacked the essence of all that Smith had supplied. These claims, therefore, cover an invention of substance manifested by the application of Smith's principle, inhering in his fundamental cooperating elements of a horizontal lure-carrying arm extending through the continuous longitudinal opening of the casing. Here then, substance is separable from form; and looking through form to substance, the form, however varied, is of no importance. *Winans v. Denmead, 15 How. 342; Machine Co. v. Murphy, 97 U. S. 120.* And since equivalency em-

bodies "substantially", Respondents having adopted the substance of the device, the variation from flexibility to rigidity or vice versa, goes to form, because there is no breaking up or change in principle but a doing of the same thing in substantially the same way. *Sanitary Ref. Co. v. Winters, 280 U. S. 30; Abercombie & Fitch v. Baldwin, 245 U. S. 198, 209.* This substantial identity is obvious when we consider that it is the idea of means, and not of form, which is determinative of identity of principle; for Smith's arm, in either form, retains its indispensible position and function that cleaves to the mode of operation.

This is confirmed by the Patent Office experts as shown by the Creveling File Wrapper (R. pp. 119, 125, 127, 128, 132, 133). Creveling specifically claimed every element of Patent 1,379,224 in his first claim "and a lure-supporting arm **sustained** on the car and extending through the slot of the housing to position the lure within the race track" (R. p. 125). This claim was rejected on Smith No. 1,379,224 (R. pp. 127, 128). The element was again repeated by way of amendment, thusly: "and a lure-supporting arm **sustained** on the car for movement over the race track" (R. p. 128). The Patent Office again rejected this Claim on May 9, 1923, stating "Claim 1 is again rejected on Smith of record in which every feature of the Claim is clearly disclosed in the same relation and performing the same function". (R. p. 132). Thereupon Creveling acquiesced by cancelling lines 6, 7, 8 of his Claim 1 reading "and a lure-supporting arm sustained on the car and extending through the slot etc.", (R. p. 133),

and so amended the claim as to claim and exhibit his true invention, for retracting Smith's arm into Smith's casing after the race to an inoperative position (R. p. 136).

The Patent Office proceedings of this Patent hereinbefore reviewed, sufficiently shows, that no quality of invention or novelty is involved in selecting a form of support, as that is in the common field of mechanical construction. See also *Thomson-Houston v. Athol, 91 Fed. 767, 765 (C. C. A. 1)* quoting with approval *Thomson-Houston v. Athol, 83 Fed. 203 (C. C.)* and recognized in *Commissioners Decisions 1897, p. 694*, where it was held, that to support a working part, whether rigidly or elastically, any mechanical engineer must select and as he may select either, such selection is mechanical skill. See also *Temco v. Apco, 275 U. S. 319, 328.* Respondents have merely transferred the support at the projecting end of the arm into its connecting end on the car without in any manner varying the principle of guiding the lure within the race course by means of the horizontal arm. The change was therefore a question of degree in the use of substantially the same means. *(Webster Loom Co. v. Higgins, 105 U. S. 580; Brush v. Condit, 132 U. S. 37, 39; Sanitary Ref. Co. v. Winters, 280 U. S. 30).*

Applying the test of interchangeability or non-interchangeability *(Miller v. Eagle Mfg. Co., 151 U. S. 208)*, the arm may be, in fact is, used in either apparatus whether supported rigidly or movably while the apparatus is in operation, for there is no radical unfitness, no radical change in function or result, merely a change in form; since the element of support pertains to the working en-

vironment of the inventive step. And it is settled that changes in form or construction of parts will not avoid infringement where the principle or mode of operation of the patent is taken; or where the changed form or construction is neither the distinguishing characteristic, nor material to the device or its operation. *Winans v. Denmead, 15 How. 342; Burr v. Duryee, 1 Wall. 531, 573; Sewall v. Jones, 91 U. S. 171; Ives v. Hamilton, 92 U. S. 426, 431; Robertson v. Blake, 94 U. S. 728, 734; Seymour v. Osborne, 11 Wall. 516, 560; Elizabeth v. Pavement Co., 97 U. S. 126, 137; Machine Co. v. Murphy, 97 U. S. 120, 125; Marsh v. Seymour, 97 U. S. 348, 359; Imheuser v. Buerk, 101 U. S. 647; Hoyt v. Horne, 145 U. S. 302, 308; Hobbs v. Beach, 180 U. S. 393, 401; Abercombie & Fitch v. Baldwin, 245 U. S., 198, 207, 208, 209; Temco Co. v. Apco Co., 275 U. S. 319, 328; Sanitary Ref. Co. v. Winters, 280 U. S. 30; Auto Vacuum v. Sexton, 239 Fed. 898 (C. C. A. 2); Litson v. Alaska, 130 Fed. 129, 142, 143 (C. C. A. 9); McSherry v. Dowagiac, 101 Fed. 716, 722 (C. C. A. 6); Metallic Extraction v. Brown, 104 Fed. 345, 353 (C. C. A. 8); Dowagiac v. Minnesota Moline Plow, 118 Fed. 136 (C. C. A. 8); Lourie v. Lenhart, 130 Fed. 122, 129 (C. C. A. 8); Wayne v. Benbow Brammer, 168 Fed. 271, 278 (C. C. A. 8); Adam v. Folger, 120 Fed. 260 (C. C. A. 7); Vroonan v. Penhollow, 179 Fed. 296 (C. C. A. 6); Wellman v. Cramp, 3 Fed. (2nd) 531, 533 (C. C. A. 6); Yancey v. Enright, 230 Fed. 641 (C. C. A. 5); Reece v. Globe, 61 Fed. 958 (C. C. A. 1); Kings County, etc., v. U. S. Consol., etc., R. Co., 182 Fed. 59, 63 (C. C. A. 9); Angelus v. Wilson, 7 Fed. (2nd) 314 (C. C. A. 9); Walker on Patents, Sixth Edition, Sec. 419, Vol. I, p. 517; Walker on Patents, Sixth Edition, Vol. I, Sec. 412, p. 501.*

(b) Witness Keen testifies: "I think that in the gid arm, the vibration of the car will in time crystallize e arm and cause it to break off. I don't believe that ndition would occur where the arm is supported by a ovable support". (R. p. 78). And on page 79 of the ecord, he reiterates his opinion and adds: "As a matter fact, I know it happened, because Mr. Smith tried the gid arm and discontinued the use of it. I believe he und the rigid arm objectionable and that is why he put e wheel at the end, because the rigid arm was not satisctory." (R. p. 79). This opinion of the witness and his lief that Smith found the rigid arm objectionable or not tisfactory, clearly indicates Smith's compliance with *Sec. 88, U. S. Rev. Stat.*, which requires the inventor to state his description the mode which he contemplates to be st. *Walker on Patents, 6th Ed., Vol. 1, Sec. 160, pp. 188, 9; Morey v. Lockwood, 8 Wall. 230; Continental Paper g v. Eastern Paper Bag, etc., 210 U. S. 405, 418; Vrooen v. Penhollow, 179 Fed. 296, 302.* There was no deviaon from his principle, no change in his fundamental coerating elements, no change in the function of his arm, erely a workshop detail or mechanical selection of a better preferential form of support as a precautionary mease against accident. (Compare *Abercombie and Fitch v. ldwin, 245 U. S., at page 209).* For we take it, that ingement inheres in what Respondents' device does, not hat it omits to do. *Hobbs v. Beach, 180 U. S. 383, 401.* that whether the flexible arm or the rigid arm works tter or worse is of no consequence. *Winans v. Denmead, How. 342; Hoyt v. Horne, 145 U. S. 302, 308, 309; rush v. Condit, 132 U. S. 37; Marsh v. Seymour, 97 U. 348, 359; Murray v. Detroit Wire Co., 206 Fed. 465,*

468 (C. C. A. 6); Nathan v. Howard, 143 Fed. 889 (C. C. A. 6); King Axe v. Hubbard, 97 Fed. 795 (C. C. A. 6); Woodward v. Boston Lasting Co., 60 Fed. 283 (C. C. A. 1); Yancey v. Enright, 230 Fed. 641 (C. C. A. 5); Scheible Co. v. Clark, 217 Fed. 760, 770, 771 (C. C. A. 6); Temco v. Apco, 275 U. S. 319, 328; Smith v. American Electric Rabbit, etc., 21 Fed. (2nd) 366, 371; Ibid, 26 Fed. (2nd) 1016.

(c) Respondents argued below in line with the District Court in *Smith v. Springdale Amusement Park, 39 Fed. (2nd) 92, 94, 95*, that regardless of Smith's reservation in his specifications and the reservation accorded him by law as to form and location, the preferred form of wheel support claimed considered in connection with Smith's escape for the lure and the preferred location of the apparatus on the right outer side of the race course, is nevertheless reduced to a voluntary limitation on the theory advanced that if the track was slightly banked at the curves, the lure would perceptibly leave the ground at such curves and in direct proportion to the angle of banking, and this accounts for the wheel support implying flexibility and the location of the apparatus on the right outer side, with the asserted conclusion that the arm rigidly supported would not work on the right outer side of the race course at the curves *(39 Fed. [2nd], pp. 94, 95, supra)*.

The specification and claims are not limited to an oval shaped race course having two outer sides, though that form is illustrated and described as one of several; it includes a rectangular or straight-of-way course, and the straight-of-way section of the illustrated oval course, as to

hich the foregoing theory is inapplicable; and yet, the se of the rigid arm will nevertheless infringe at some stage f its operation it not being necessary that it should in- ringe at all stages. *Sewall v. Jones, 91 U. S. 171; Hoyt v. lorne, 145 U. S. 302, 308; Farrington v. Haywood, 35 Fed. 2nd) 628, 631 (C. C. A. 6).*

The statement that the lure would perceptibly leave he ground on the curves because of banking is, we think, nadvertent, unless the angle of the banked railbed is dis- roportioned to the angle of the banked course-bed; for hat is meant is, that the lure on the end of the rigidly upported arm would travel closer to the ground at the urves on that side and leave the ground at the curves on he other side, since the rigid arm assumes the same in- ined position as the car, produced by the banking of the ailbed. On the other hand, it is inadmissible (and without ny engineering authority or evidence) to bank the course- ed around the curves so as to fit the assumption, which e believe is opposed to the appropriate manner of con- ruction under given conditions. For the hypothesis fails take into consideration the length of the arm and the nportance of grades of course-bed and railbed, so indis- ensable in engineering practice. The unchanging position f the moving rigid arm relative to the course-bed is regu- ted and proportioned around the curves according to suit- ble grades of course-bed and railbed. By raising the de- red grade of the railbed and lowering the desired grade f the course-bed, the angle of banking the railbed at the urves has practically no effect upon changing the extend- g position of the rigid arm relative to the bed of the urse. The record is barren of any evidence tending to

support the engineering opinion of either the District Court or Circuit Court of Appeals. We believe it is opposed to common as well as to engineering experience. On the other hand, these details of designing the railbed and course-bed for cooperation with the rigidly supported arm is purely a matter for the engineer; it is outside the patent. With the movable support of the arm, no raising of the railbed or lowering of the course-bed is required, which may or may not account for Smith describing and claiming this subordinate element in the mode he considered best for the application of his principle and the functioning of his fundamental cooperating elements. In view, therefore, that the wheel support of the arm, implying flexibility, furnished an accessory to his underlying invention, the liberal rather than the strict rule of equivalency obtains, especially in the Sixth Circuit. *Wellman v. Cramp, 3 Fed. (2nd) 531, 533 (C. C. A. 6); Safety Automatic v. Edwards, 7 Fed. (2nd) 92, 94 (C. C. A. 6); Bundy v. Detroit, 94 Fed. 524, 538 (C. C. A. 6); McSherry v. Dowagiac, 101 Fed. 716, 722 (C. C. A. 6).*

Nor is the preferred form affected or converted into a voluntary limitation by Smith's means in providing an escape of the lure into the casing at whatever desired point on either side of the course. The claims are not concerned with this feature; on the other hand, the escape is effected by switching the conveyor car, and obviously, whether the wheel support or the rigid support of the arm is used, the car, may be switched anywhere, in the straight-of-way or around the curves, on either side. This is manifest. (R. pp. 186, 192a).

(d) With respect to placing the apparatus on either outer side of the race course, the Courts are substantially in accord. *Magic City, etc., v. Smith, 38 Fed. (2nd) 170, 173; American Electric Rabbit, etc., v. Smith, 26 Fed. (2nd) 1016,* and *Smith v. American Electric Rabbit, etc., 21 Fed. (2nd) 366, 369; Smith v. Springdale, etc., 40 Fed. (2nd) 173.*

As shown in the specifications and drawing, the apparatus is preferably located on the right outer side, (see drawing, R. p. 186) the offending device being located on the left outer side. Not having expressly limited himself to any one outer side, the transposition is unsubstantial, *(Smith v. American Electric Rabbit, etc., 21 Fed. [2nd] p. 369,* and cases there cited), there being no change in function, operation or result.

POINT D.

Patent No. 1,507,439 describes and claims Smith's starting cage in the preferred form.

Though not definitely deciding that this Patent is invalid for want of invention, the adverse opinions below seem to believe that it involves the exercise of ordinary mechanical skill. (R. pp. 98, 371; *39 Fed. [2nd] 97; 40 Fed. [2nd] 175).* Unless we ignore the ritual *(Webster Loom Co. v. Higgins, 105 U. S. 580; Western Electric v. LaRue, 139 U. S. 601, 606),* or unless hindsight is to be looked upon with favor, *(Potts v. Creager, 155 U. S. 597, 607, 608; Kurtz v. Belle Hat, 280 Fed. 277 (C. C. A. 2),* Smith was the first and only one who had given to the art a device for starting racing dogs which ordinarily would be

or is capable of being done by hand, to say nothing of its superiority in efficiency and result over the human hand. For starting racing dogs (six or more) by hand, obviously presents problems and difficulties for fair and equal starting that this apparatus has solved.

Fair and equal starting is the object in view. With horses, when the barrier is raised, starting depends on horse and rider; with dogs, when the exit door is thrown out, starting depends exclusively on the hound. Besides, skeleton cages or stalls exhibited by the horse-starting references will not restrain or hold dogs in preparation of the start because of well recognized dissimilarities. Aside from noting the many characteristic differences between the temperament of dogs, horses and other quadrupeds, or between horse-starting and dog-starting, the Courts below were constrained to call in the horse-starting art.

Reservedly assuming the relationship, Smith's object was to provide a light weight box or cage having a plurality of stalls, a separate stall for each dog pending its release from the cage, the stalls so constructed as to protect the dogs from injury while confined in the cage and give them all an equal opportunity in the race by simultaneous releasing effected by a quick opening of a single exit door, and the immediate removal of the cage from the track after such releasing. (R. p. 223). It is apparent that Smith's purpose in providing for wire mesh partitions was to give lightness so as to effect such removal, whereby the track is freed from the obstructing cage during the race. And the purpose in providing that the partition walls be partially covered with fabric was to protect

the dogs from being injured by their pressing or rubbing against the wire screen. (R. pp. 223, 224). This detail, however, is not of the essence of the invention. Clearly, that is mechanical selection, and what Smith had considered the best mode for separating the dogs in a light weight box and for protecting them against injury during their confinement; for he says, the invention is not restricted to the exact details of construction disclosed herein, yet for the purpose of illustrating a particular embodiment, etc. (R. p. 223) and he further says "other means (that is to say other than fabric on wire mesh) may be employed to protect the dogs against injury in the stalls, without departing from the spirit of my said invention". (R. p. 224). Again:

> "At the front of the cage I have provided the door 6, opening upwardly and outwardly, being mounted by hinges as 7, 7, at the top of the cage and having the latch 8 near the bottom of the cage to hold it in position when closed. For the purpose of opening said door quickly when the latch 8 is released, I have provided the timbers 9, 9, extending above and out in front of the cage, as shown, and attached to the end thereof are the coiled tension springs 11, 11. The lower ends of the springs 11, 11, are attached in suitable eyes, as 10, 10, near the lower edge of the door 6". (R. p. 224; R. p. 222).

From the above quotation read in connection with the drawing, it is submitted that the gist of the invention as claimed, is the front exit door hinged to the top wall of the cage in cooperation with inclined members secured to the top of the frame, extending upwardly and outwardly beyond the face of the front door and connected at their outer ends with springs, the lower ends of the springs being

attached to the lower edge of the door whereby the door is thrown open upon release of the latch. The functioning of these cooperating elements in producing that movement is present in Respondents' cage. (R. pp. 71, 72, 73, 78, 143, 144, 145).

Upwardly inclining the members provides a greater arc in the upward and outward movement of the door, thereby lessening shock and eliminating excessive rebound of the opened door, thus avoiding the possibility of the door striking the dogs as they are released as well as maintaining the fixed position of the box until the operation is completed. These inclined members are shown to be divergent and the tension springs coiled. As to these details, no express limitation appears; for in addition to the reservation of all other forms or details of construction (R. p. 223) the specification further provides: "It will be apparent that other means may be employed to raise the door 6 * * * without departing from the spirit of my invention". (R. p. 224). So in moving the inclined members from divergent to non-divergent (R. pp. 71, 72, 73, 78, 143, 144, 145) and substituting rubber for coiled tension springs without change in function, there is no departure from the spirit of the invention thus described and claimed in the preferred form. We, therefore, think, the Courts below erred in finding that "the case is not one of showing the preferred form". (R. pp. 98, 371; *39 Fed.* [*2nd*] *97; 40 Fed.* [*2nd*] *175).*

(b) It is next to inquire if the case is one of limitation of the scope of the invention by the prior horse-starting art. In none of the horse-starting patents can we

find the essence of Smith's invention exhibiting his fundamental cooperating elements of hinging the upper end of the front exit door to the top wall of the box in combination with inclined members (whether divergent or non-divergent) extending upwardly and outwardly and connected at their outer ends with tension springs and latch for producing Smith's movement in opening the front door 6. Escude (R. pp. 324, 325) raises his net or barrier (stretched across the race track) by latch and springs from the end of two horizontal projecting members pivoted near the lower end and to the side of an upright; nor are his projecting members secured to the top of a frame, nor is his barrier in any way connected to the top wall of a frame because he has no top of a box or frame and no top wall at all. Stitzer (R. pp. 330, 331) opened his exit gate by latch or locking rod and springs surrounding and bearing against a post for sideways swinging outwardly but not upwardly; Stedeker (336, 337, 338) by latch and springs for vertical up-sliding movement of his bar but not outwardly; Andrew (R. pp. 318, 319) springs and weights and releasing levers for vertical up-sliding movement of his exit door but not outwardly; Whitehead (R. pp. 311, 312, 313) weights, springs or lift mechanism for vertical upward movement of his exit door but no outwardly. Briefly, in Stedeker, Andrew and Whitehead, the door slided up, in Stitzer it opened sideways, and in Escude, upwardly and outwardly, with no hinging of his barrier to the top wall of a box and with a horizontal projecting arm, not inclined upwardly, but se-

cured to two uprights. In none of these references is there a hint of hinging the upper ends of an exit door or barrier to the top walls of a box, no inclined member or arm (whether divergent or not) extending upwardly or secured to the top of a frame or box.

Each and all of these references exhibit open work affairs, uprights, bars, gates, doors or barriers sliding up or swinging sideways or pivoted to a standard or upright, as in Escude—mechanisms so radically different from Smith's operating means, incapable of producing movement in the same way, that no mechanic could, with the specifications and drawings of these Patents construct Smith's starting box out of any of them without the exercise of the inventive faculty.

Smith does not broadly describe and claim a single exit door which can or might be raised by springs connected to projecting arms secured to two uprights located on the outer or inner sides of a race course, as the adverse opinions below would have it. Smith's underlying invention adopted by Respondents is limited to and specially adaptable for dog starting. It is obviously useless for horse starting. The adverse opinions below are therefore believed to be erroneous in holding that the claim is limited in scope by the horse starting art to wire mesh partitions partially covered with fabric, divergent and not non-divergent inclined members supporting the springs and coiled tension springs, in that the Courts below have ignored Smith's fun-

damental cooperating elements designed and functioning to produce a specified movement for efficient dog starting and characteristically distinguishable from the horse-starting references.

(c) Coming to the File Wrapper (R. pp. 193 to 224 a) we are unable to discover that Smith was required to include these subordinate elements in order to secure the allowance of his claim; but on the contrary, each of the subordinate elements of wire mesh partitions partially covered with fabric and the divergent arms supporting the springs when included in broad claims reading on the horse-starting references were rejected and the rejections were acquiesced in by Smith thereby indicating that both Smith and the Patent Office had regarded these elements as non-essential and as involving neither invention nor novelty. It was only when Smith had narrowed the scope of his underlying invention, manifested by his fundamental cooperating elements to distinguish it from the horse-starting references that the claim was allowed, thus leaving these subordinate elements within the domain of a preferential form.

The first three rejected claims appear on pages 197, 198 of the Record. Each claim includes (a) (Claim 1) "wire mesh upon said frame, fabric covering a portion of said wire mesh"; (b) (Claim 2) "a net work upon said frame"; (c) (Claim 3) "a transparent covering upon a portion of said frame". They also include (a) (Claim 1) "a common exit door with special means for opening said exit door"; (b) (Claim 2) "a common front exit door for all the stalls and means for opening said exit door when released"; (c) (Claim 3) "a front door common for all of said

stalls, a latch for said front door, and springs opening said front door quickly when released". These three claims were rejected on each and every horse-starting reference; Whitehead, Andrew, Stitzer, Stedeker and Escude (R. p. 201). As none of them show a net work, wire screen, or transparent covering, or fabric "upon said frame", the necessary inference is that such covering or material involved neither invention nor novelty but a detail insufficient to distinguish it from any one or all of the references, otherwise the claim would have been allowed as a patentable improvement on each or all of them. Whitehead (R. pp. 311, 312, 313) and Andrew (R. pp. 318, 319) show separate exit doors sliding vertically upward by means of latch, weights, levers and tension springs, Stitzer (R. pp. 330, 331) separate gates swinging sideways, Stedeker (R. pp. 336, 337, 338) by latch and springs for vertical upward movement of his sliding bar and Escude by a single front net stretched across the course, pivoted to the side of his uprights and released by latch and springs. From the rejection therefore, Smith has disclaimed wire screen partitions partially covered with fabric as an essential element and further disclaimed the means for releasing his front door as disclosed by these references.

Upon cancellation (R. p. 202) Smith presented the following:-

> "In a starting cage for racing dogs a frame comprising a box-like structure divided into a plurality of compartments, individual rear doors for each of the compartments and a single front door pivoted at its upper end to the side walls of the frame, divergent inclined members carried by the said frame and extending beyond the face thereof

and having its (sic) outer ends in vertical alignment with the side walls of the box-like structure, springs secured to the said outer ends and to the door and a latch for securing the door in its closed position." (R. p. 202).

Turning to the drawings of Andrew (R. p. 319, Fig. 4) and Stitzer (R. pp. 330, 331) it will be noticed, that Andrew's sliding-up doors are each pivoted at both ends to the side walls of his frame, that Stitzer's sideway swinging gates are each pivoted at both ends to their posts, and likewise in Escude his net is pivoted at its upper end to the side walls of his upright (R. p. 324, fig. 1, elements c, m, fig. 2, m). Whilst Andrew and Stitzer have no single front door common to their separate skeleton stalls, Escude shows a barrier or net stretched across from standard to standard. It will also be noticed that while Escude's projecting member is neither divergent nor inclined, it is nevertheless carried by or secured to his standard, and has its outer ends in the plane of the side wall thereof and extends beyond the face of his barrier when closed.

It is not to be wondered at that the Examiner rejected the claim as follows: " 'vertical alinement with' implies incorrectly that the ends are directly above the walls. What applicant means is that the ends are in the same planes as the side walls. The Claim is rejected on each of Andrew and Stitzer in view of Escude which suggests the 'single front door', springs and latch. This produces structure fully equivalent to that claimed". (R. p. 203). It results from this rejection and Smith's acquiescence therein by cancellation (R. p. 204) that "divergent inclined members" carried by a frame and extending beyond the face

thereof and having their outer ends in vertical alinement with the side walls involved nothing patentable on Escude's horizontal non-divergent member carried by his standard or upright—in short, whether such a projecting member is divergent or non-divergent involves neither invention nor novelty. For if the examiner had regarded that the only novelty in the claim was the divergent inclined members as constituting the essence of the invention covered by that claim and differentiated from the art of record, the claim would have been allowed, but his rejection was that the claim was for a single front door, springs and latch which produced structure equivalent to Andrew and Stitzer in view of Escude.

Upon cancellation, Smith presented a new claim (R. p. 204) which after an amendment (immaterial to the matter in hand) (R. pp. 206, 205, 204) was allowed (R. p. 207), and became the single claim of the Patent. It was therefore the hinging of the front door to the top wall of the box in cooperation with inclined members secured to the top of the box extending upwardly and outwardly beyond the face of the front door with springs and latch, that distinguished the claim from the horse starting references and thus narrowed in scope, constitutes the essence of the claim and the invention, leaving the elements of wire mesh partitions partially covered with fabric and divergency of the inclined members as subordinate and non-essential in virtue of the rejections and Smith's acquiescence therein.

It is, therefore, submitted that (1) the invention is described and claimed in the preferred form, (2) the form or divergency of the inclined members supporting the

springs and the wire mesh partitions partially covered with fabric were regarded by the Patent Office and acquiesced in by Smith as non-essential to distinguish from the horse-starting patents, and (3) by the rejections and allowance, the scope of the invention and claim is limited to those fundamental cooperating elements hereinbefore set out and as so limited constitutes the distinguishing characteristic appropriated by Respondents.

POINT E.

Respondents have infringed the single claim of Patent No. 1,507,439 by substituting wooden boards for wire mesh partitions partially covered with fabric, arranging or locating the inclined members supporting the springs from divergent to non-divergent, and substituting shock rubber for coiled tension springs.

It is not pretended that Respondents are using any of the devices exhibited by the horse-starting references, nor is it disputed that they have adopted the fundamental cooperating elements functioning in substantially the same way for opening the exit door. (R. pp. 71, 72, 73, 76, 144, 145).

(a) Substitution of wooden boards for wire mesh partitions partially covered with fabric, not being indispensable to the novelty of the claim, is colorable. *Florsheim v. Schilling, 137 U. S. 64; Hotchkiss v. Greenwood, 11 How. 248; Hicks v. Kelsay, 18 Wall 670; Outlook Co. v. Malco Co., 299 Fed. 996 (C. C. A. 6); Wise, etc., Co. v. Bishop-Babcock Co., 240 Fed. 733 (C. C. A. 6.)* Leastwise, there is impairment of function, *King Axe Co. v. Hubbard, 97 Fed. 795 (C. C. A. 6); Nathan v. Howard, 143 Fed. 889*

(C. C. A. 6); and whether wooden boards are better or worse is of no consequence. *Hoyt v. Horne, 145 U. S. 302, 308, 309; Brush v. Condit, 132 U. S. 37; Temco v. Apco, 275 U. S. 319, 328; Smith v. American Electric Rabbit, etc., 21 Fed. (2nd) 366, 375, 376; Ibid, 26 Fed. (2nd) 1016.*

(b) Transposing the position of the upwardly inclined members from divergent to non-divergent is likewise colorable, there being no change in mode of operation or result for opening the front door. *Ives v. Hamilton, 92 U. S. 426; Brown v. Guild, 23 Wall 181; Winans v. Denmead, 15 How. 342; Machine Co. v. Murphy, 97 U. S. 120; Devlin v. Paynter, 64 Fed. 398 (C. C. A. 3); Metallic Ex. Co. v. Brown, 104 Fed. 345, 353 (C. C. A. 8); Hutter v. De Q. etc., 128 Fed. 284 (C. C. A. 2); Union Steam Pump v. Battle Creek, 104 Fed. 342 (C. C. A. 6).* If better or worse is of no importance, *Webster Loom Co. v. Higgins, 105 U. S. 580; Hoyt v. Horne, 145 U. S. 302, 308, 309; Temco v. Apco, 275 U. S. 319, 328; King Axe Co. v. Hubbard, 97 Fed. 795 (C. C. A. 6); Nathan v. Howard, 143 Fed. 889 (C. C. A. 6); Lourie v. Lenhart, 130 Fed. 122, 129 (C. C. A. 8); Smith v. American Electric Rabbit, etc., 21 Fed. (2nd) 366, 375, 376; Ibid., 26 Fed. (2nd) 1016.*

(c) Substitution of rubber springs for coiled tension springs is also colorable. See authorities above cited.

It is believed that Respondents' structure was designed to evade the spirit of the invention by appropriating all that is of value; so, whether the function of the elements of the claim are impaired or bettered by such evasions but which remain substantially the same, Respondents have infringed.

In the opinion of the District Court (R. p. 98) *39 Fed. (2nd) at page 97*, it is stated that respondents omit "apparently the springs themselves (Defendants' Exhibits E. and F). In lieu of springs the single front door is opened manually with the assistance of counterweights". This is error. Defendants' Exhibits E. and F. (R. pp. 144, 145) confirm the uncontradicted testimony (R. pp. 71, 72, 73, 76) and plainly show the airplane shock rubber with snap hooks secured to the outer ends of the inclined members and to the bottom of the door. Nor is the door opened manually with the assistance of counterweights; that is done by pulling the lever releasing the latch. (R. pp. 72, 73). On the other hand, the counterweight is plainly an addition, which, of course, is immaterial. *Temco v. Apco, 275 U. S. 319, 328.*

POINT F.

Patent No. 1,507,440 is valid.

(a) The Courts below decided that this Patent is invalid for want of invention and novelty, but if valid is not infringed. (R. pp. 95, 96; 368, 371) *39 Fed. (2nd) 96; 40 Fed. (2nd) 175.*

In his specification, Smith says: "My invention relates to means for concealing the track and conveyor car in a mechanical lure conveyor for dog racing courses. The object is to provide a suitable housing for concealing the track and conveyor car from the dogs and which form a continuous housing around the race course with a continuous opening upon the side towards the course". (R. p. 255). Again, "In the foregoing construction, it will be seen that the entire track and conveyor car are concealed from the

dogs, the only portion being exposed to view are the arm and parts mounted thereon." (R. p. 256). Nor is the invention intended to cover or does cover housing other than for dog racing apparatus having a laterally extending arm, for each claim contains the relative and limiting introductory phrase "In a housing for covering tracks and cars having laterally extending arm operated upon said track", etc., and "in a continuous housing for concealing", etc. (Claim 1, 2, 3, R. pp. 256 and 256a). And furthermore, the Examiner indicated that the claims be thus confined as a basis for his consideration and allowance. (R. p. 233).

Keeping in mind this limitation, the patent relates to the casing element called for in Patent No. 1,379,224, and a result of a separate application co-pending with and divided out of that Patent Application as suggested and required by the Examiner. (R. pp. 168, 169, 170). Accordingly, it is a subcombination patent, operating conjointly as to use with those elements of Patent No. 1,379,224, in performing the subordinate interdependent function of concealment and is therefore expressly limited in its utility to perform its appropriate function in a dog racing device having a laterally extending arm and of which it forms a part. *Philadelphia, etc., R. R. Co. v. Dubois, 12 Wall. 47; Gill v. Wells, 22 Wall 1; Canda v. Michigan, 124 Fed. 486, 489, 490 (C. C. A. 6); Thomson-Houston v. Black River, etc., 135 Fed. 759 (C. C. A. 2); Thomson-Houston v. Elmira, 71 Fed. 396 (C. C. A. 2).*

Minus the expressed relation and limitation, the housing described is minus utility. That relation suggested the idea of concealment, but how and in what man-

ner? There may be many ways for carrying it out but any manner is necessarily conjoined with the disclosure embodying the limitation, thus constituting an improvement on or addition to the original invention.

This contribution is exhibited by the Walsh Patent, which has as its fundamental element a laterally extending arm, angular tough it be, yet operating on the track in vertically inclined planes. Like Smith, he realized the necessity of concealing his mechanisms from the dogs, and he stepped in that direction, not by means of a housing but by means of a relatively high fence. As heretofore shown, Smith carried out this idea of concealment, but in a radically different way; by placing his fence on the far side of the rail track and from its upper end bringing it over towards the outer side of the course, thus producing cooperation in the free movement of his arm through the longitudional opening and that of concealing the mechanisms from the dogs. It never occurred to Walsh or to any mechanic having his patent before him to conceal his mechanisms other than by means of a fence, but the same idea of concealment occurred to Smith and he carried it out by another and different means. *Hobbs v. Beach, 180 U. S. 383, 392, 393.* So, what would have occurred to a mechanic without his exercising the inventive faculty, is clearly uncertain, inconclusive, unreliable and hindsight skill. *Hobbs v. Beach, 180 U. S. 383, 392; Webster Loom v. Higgins, 105 U. S. 580; Kremetz v. Cottle Co., 148 U. S. 556; Potts v. Creager, 155 U. S. 597, 608; Leeds & E. Co. v. Victor, etc., Co., 213 U. S. 325, 332, 333; Kurtz v. Belle Hat, 280 Fed. 277, 281 (C. C. A. 2).*

Slotted tubing, housings for third rail, coverings for loading platform, canopies at the entrance of hotels, theatres and residents, are not adaptable for or combine all the elements, functioning substantially in the same way as the housing in suit, or having the same objects and purposes and producing or being capable of producing the same result of covering or concealing tracks and cars having laterally extending arm operating on a dog race course *(Eibel Process Co. v. Minnesota Co., 261 U. S. 45, 66; Seymour v. Osborne, 11 Wall. 516, 542, 543; Canda v. Michigan, 124 Fed. 486, 492.* But Bertram (R. p. 343) is said to anticipate.

Glancing at Bertram's specifications and his third rail cover, it was designed with a view of protecting the third rail from the weather, snow, sleet, etc. He had no purpose of covering or concealing tracks and cars having laterally extending arm operating on a dog race course. Bertram's cover consisted of a bottom board, a vertical side board insulated, a top board and two side boards separated by a longitudinal opening, all nailed and joined together to form a continuous cover and supported integrally by reason of its small size. Ordinarily, whilst size, proportion and degree are inconsequential factors, in Bertram's cover, they are essential and functional since any increase in size, proportion or degree, would be objectionable and unnecessary. It is so small, that the rigidity of its frame is inherent in the structure, requiring no posts, timbers attached to posts, boards or truss rods adapted to support the side above the continuous opening. This furnishes an additional reason why Bertram's construction was limited to its own special purpose. Smith's housing

could not stand without posts, timbers, boards and truss support of his top side.

It is argued that Smith's changes being structural, any mechanic could have done it, but, in rejoinder, such a change produces a more useful, beneficial and different result coupled with the presumption arising from the grant and the extensive use of Smith's housing in the dog racing art. *(Seymour v. Osborne, 11 Wall. supra; Canda v. Michigan, supra).* So Bertram's patent cannot be considered as an anticipation since it does not disclose the purpose, means and mechanism for accomplishing the end of the patent in suit, and which are restricted by Bertram's disclosure to the accomplishment only of a substantially different and limited purpose. For, accidental results, not intended and not appreciated, do not constitute anticipation. *Eibel Process v. Minnesota & Co., 261 U. S. 45, 66; Gordon Form & Co. v. Wolcott & Co., 32 Fed. (2nd) 55 (C. C. A. 6)*, and cases there cited. *Western Electric v. LaRue, 139 U. S. 601; Hobbs v. Beach, 180 U. S. 383, 392; Tilghman v. Proctor, 102 U. S. 707, 711.*

Since, therefore, Bertram's cover was not designed by him, nor adapted nor actually used for the performance of the function of concealing lure conveyor mechanism having laterally extending arm operating on a dog-race course, it is not anticipation that Bertram's cover might, by modification, be made to accomplish the function of the patent in suit. *Topliff v. Topliff, 145 U. S. 156, 161; Seymour v. Osborne, 11 Wall. 516; National Hollow B. B. Co. v. Interchangeable Co., 106 Fed. 693 (C. C. A. 8); Canda v. Michigan, 124 Fed. 486 (C. C. A. 6); Wayne v.*

Benbow Brammer, 168 Fed. 271, 277. Nor does it constitute anticipation and no defense to a claim for infringement, that one or more parts of a patented improvement may be found in one old patent or publication, and others in another and still others in a third. It is indispensable that all of them or their mechanical equivalents be found in the same description or machine, where they do substantially the same work by substantially the same means. *Bates v. Coe, 98 U. S. 31, 48; Imheuser v. Buerk, 101 U. S. 647, 660; Seabury v. Am. Ende, 152 U. S. 561, 568; Hobbs v. Beach, 180 U. S. 383.* And as "that which infringes if later, will anticipate if earlier", Bertram would not infringe on Smith for he omits every element of the claim except boards and the longitudinal opening.

(b) Turning to the File Wrapper (R. pp. 225 to 241) this claim (R. p. 234) was allowed and remained allowed at all times. The rejections of other claims had no limiting effect as to this Claim 1. Original Claims 1 to 4 (R. pp. 229, 230) were rejected as indefinite and as aggregations, and the Examiner suggested amendment so as to confine them to a housing for covering or concealing the car having a laterally extending arm. (R. p. 233). Conformably to the suggestion, four new claims were presented (R. p. 234). New Claim 2 (being Claim 1 of the Patent) was allowed. (R. pp. 234, 237). New Claims 1, 3, and 4 were rejected on Bertram (R. p. 237), cancelled (R. p. 238) and amended new claims 2 and 3 presented (R. p. 238). As thus amended, these new Claims 2 and 3 were allowed and Claim 2 (Claim 1 of Patent) again allowed. (R. pp. 239, 240, 241).

Inserted amended Claims 1 and 4 rejected on Bertram, as in Bertram, made no provision different from Bertram for supporting any side of the housing (R. p. 343); inserted or amended Claim 3 broadly claimed "means for supporting", etc., whereas Bertram's means of support was integral in his cover by virtue of its size, or by his inverted L-shaped third rail functioning accidentally as a bracket. (See b, b, Fig. 1 of drawing, R. p. 343). So that, on the cases cited in our discussion of File Wrapper of Patent 1,379,224, the estoppel as to allowed claims previously rejected on Bertram is, that Smith is estopped from maintaining that these amended claims as allowed, cover Bertram's combination, or from now claiming that these claims have the same breadth as the amended and rejected Claims 1, 3 and 4, namely, that the support of the side above the continuous opening is integral in the structure or by means of a bracket which, of course, has no truss function. Nowhere in Bertram is a truss function discernable or even suggested; nor is it pretended that the side of Respondents' housing above the continuous opening is supported as in Bertram, nor that Respondents are using Bertram's cover. *Griswold v. Harker, 62 Fed. 389, 393 (C. C. A. 8); Imperial Machine v. Blakeslee, 262 Fed. 419, 423 (C. C. A. 2).*

POINT G.

Respondents have infringed Claim 1 of Patent No. 1,507,440 in letter and spirit.

(a) In letter and spirit, Respondents' housing reads directly on this Claim (R. pp. 71, 72, 73, 75, 76, 78, 142, 117). Respondents' rod is attached to the closed or rear side of the housing and is adapted to support the side

of the housing above the continuous opening by being fastened to an over-hanging beam in continuation of the side above the continuous opening, denominated cantilever, and producing a triangular tie or truss—a cantilever truss. There is also an additional truss rod or truss (R. p. 142). As the claim reads "truss rods adapted to support, etc." it comprises every kind of truss construction. *(Webster's New Int. Dict. [Merriam Ed.] 1927, verbo Truss in Arch-Engin.).* There is substantial identity of function, operation and result. *Sanitary Ref. Co. v. Winters, 180 U. S. 30; Smith v. American Electric Rabbit, etc., 21 Fed. (2nd) 366, 372, 373, 374.*

It is respectfully submitted that the decision and decree of the Sixth Circuit Court of Appeals be reversed.

JOHN E. SATER,
E. HOWARD M'CALEB,
Counsel for Hannah M. Smith, Administratrix, Petitioner.